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Paper No. 16
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **International Business Machines Corporation**

Serial No. 75/251,068

Alexander Tognino for applicant.

Mary E. Crawford, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Quinn, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by International
Business Machines Corporation to register the mark
SANFRANCISCO for "computer software for use in the creation
of other software using object oriented frameworks."¹

The Trademark Examining Attorney has refused
registration under Section 2(e)(3) of the Trademark Act on
the ground that the mark, if used on the goods, would be

¹ Application Serial No. 75/251,068, filed March 4, 1997,
alleging a bona fide intention to use the mark in commerce.

primarily geographically deceptively misdescriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

In order to establish a *prima facie* case for refusal of registration under Section 2(e)(3), the Examining Attorney must show that the public would believe that the goods for which the mark is sought to be registered originate in the geographic place named in the mark when, in fact, the goods do not originate in that geographic place. In *re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999), *aff'g*, 48 USPQ2d 1689 (TTAB 1998); In *re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In *re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and In *re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

In support of her *prima facie* case, the Examining Attorney offered listings for "San Francisco" from a general dictionary (*The American Heritage Dictionary of the English Language* (3rd ed. 1992)) as well as from a geographical dictionary (*Webster's New Geographical Dictionary* (1988)). The Examining Attorney also relied upon excerpts retrieved from the NEXIS database which,

according to the Examining Attorney, show that the San Francisco Bay Area is known for computer software development, and that an area of the city ("south of Market" also called "SOMA") is known as "Multimedia Gulch." Also of record are web pages pulled off the Internet, including one of the San Francisco Chamber of Commerce stating that "San Francisco's Multimedia Gulch has continued to grow as a center of Internet-content and software firms." The Examining Attorney maintains that the primary significance of the term "San Francisco" is geographic and that purchasers are likely to believe that applicant's computer software originates in San Francisco when, in fact, it does not.

Applicant contends that the mark sought to be registered is not primarily a geographic term, pointing out that "San Francisco" is the Spanish name for Saint Francis who founded the Franciscan order of monks, the second largest order in the Roman Catholic church. Applicant asserts that "[t]he city in California is named for Saint Francis and developed around the site of a Franciscan mission, originally known as San Francisco de Asis....[t]hus, the primary significance of San Francisco is to identify San Francisco and not the city." (brief, p. 4) Applicant goes on to cite other geographical dictionary

listings of geographic locations which it alleges are named after the saint. Applicant concludes that "the primary significance of San Francisco is not the city in California, but the Saint after whom the city and a variety of geographical places were named." (brief, p. 5) With respect to a goods/place association, applicant relies upon more recent editions of geographical dictionaries, gazetteers and on-line resources which do not list "computers" as one of the industries in the city of San Francisco. Applicant also critiques the NEXIS articles introduced by the Examining Attorney. Applicant contends that "it is not San Francisco that is associated with computer software but only the small portions of it designated as Multimedia Gulch and/or South of Market." (brief, p. 8) Applicant also asserts that the city of San Francisco and the area known as "Silicon Valley" are two distinct geographic locations. Applicant further argues that the nature of the software business, that is, the fact that people can access the Internet and download software with the push of a button, eliminates the association of a geographic location with the origin of the software. Applicant also introduced the declarations of five individuals who are acquainted with the computer industry, all opining that the city of San Francisco is not

associated with the production of software. In relying on these declarations, applicant points out that purchasers of its goods are software programmers and others involved in software development who are sophisticated and would readily discern that the mark sought to be registered indicated origin in applicant rather than conveying a primary geographic significance. Lastly, applicant has stated that its goods do not come from San Francisco.

Contrary to applicant's argument, it hardly need be stated that "San Francisco" is the name of a major city in California. San Francisco is not an obscure geographic place, but rather is generally known to the public. This fact is clearly established by the evidence of record. In the face of such evidence, applicant's contention that the primary significance of the term is the name of Saint Francis is disingenuous and, quite simply, ignores reality.

We thus focus our attention on the central issue in this case: whether the public would believe that the software for which the mark SANFRANCISCO is sought to be registered originates in the geographic place named in the mark when, in fact, the goods do not originate in that geographic place.

Based on the record before us in this appeal, we find that it is reasonable to assume that consumers encountering

applicant's SANFRANCISCO mark will mistakenly believe that the software sold thereunder has its origin in the city of San Francisco or is otherwise connected with San Francisco. As shown by the NEXIS articles, and the web page of the city's Chamber of Commerce, computer software and related goods and services emanate from San Francisco and the larger metropolitan area known as the San Francisco Bay Area. Examples include the following:

Key industries include multimedia, computers and electronics. Also high in terms of job growth will be the computer-services and commercial-art components of the multimedia industry. In fact, while San Jose remains the high-tech capital of California, San Francisco is adding high-tech jobs at a faster pace, according to the *California Cybercities* report issued by the American Electronics Association. San Francisco's Multimedia Gulch has continued to grow as a center for Internet-content and software firms. (*San Francisco Chamber of Commerce web page*, accessed January 3, 2000)

All the new projects are clustered in the northeast section of an area known as "south of Market," which lies south of Market Street, the city's main downtown commercial corridor. The burgeoning district is home to most of the software, multimedia and Internet companies that have quickly become a major force in the city's economy. One part of the district has earned the nickname Multimedia Gulch. (*The New York Times*, August 29, 1999)

San Francisco's Multimedia Gulch continued its rapid rise as a center for Internet-content and software firms....
(*The San Francisco Chronicle*, October 6, 1998)

...Multimedia Gulch, a ten-square-block area of converted warehouses that burst with software companies specializing in CD-ROMs, Internet services and the like.
(*City Journal*, Autumn 1998)

Welcome to the cultural hub of San Francisco's trendy interactive media district, otherwise known as Multimedia Gulch. In the half-decade since software companies began migrating north from sprawling Silicon Valley into converted warehouse space in this condensed 10-square-block area, San Francisco has overtaken its southern suburban neighbor as the more popular home of interactive media, a catchall label that has come to mean everything from Internet service companies and Web site developers to interactive game makers and CD-ROM publishers.
(*The New York Times*, March 2, 1998)

Multimedia was identified in a Coopers & Lybrand study prepared for the summit as the fastest-growing sector of San Francisco's economy....
(*The San Francisco Examiner*, February 28, 1998)

Given the primary geographic significance of the term "San Francisco" (or "SANFRANCISCO" as a unitary term),² and the

² Applicant's depiction of the mark as one term instead of two terms does not detract from the primary geographic significance of the mark as a whole.

fact that the city enjoys a rapidly growing multimedia industry, we find that consumers will indeed make a goods/place (computer software/San Francisco) association. In our view, the evidence establishes that consumers would expect computer software to have their origin in the city of San Francisco. Applicant's insistence that "it is not San Francisco that is associated with computer software but only the small portions of it designated as Multimedia Gulch and/or South of Market" misses the mark. The simple fact remains that these locations are within the city of San Francisco and, according to press reports, have garnered some notoriety in the industry.

Applicant's arguments and evidence do not compel a contrary result in this case. In making our decision in this appeal, we have considered the updated editions of geographical dictionaries and gazetteer supplied by applicant. In doing so, we have noted, as cited by applicant, that the more recent texts do not list "computers" or related products and services as emanating from San Francisco. The absence of such products from the list of goods made in San Francisco does not trouble us inasmuch as the location does not need to be "known for" the goods at issue for us to affirm the refusal. In re Loew's Theatres, Inc., supra at 867; and In re Pan-O-Gold

Baking Co., 20 USPQ2d 1761 (TTAB 1991). In any event, the Examining Attorney's evidence outweighs the absence of an entry for computer-type goods under the listing for "San Francisco" in geographical reference publications.

The fact that applicant's "computer software for use in the creation of other software using object oriented frameworks" is purchased and used by sophisticated purchasers, such as computer programmers, is also not a persuasive argument. In this connection, applicant submitted the form declarations of five individuals who are in the software field. The individuals set forth their educational backgrounds and job responsibilities, with each one attesting to his or her company's licensing of applicant's software from applicant under the applied-for mark. The declarants then stated the following³:

I am aware that San Francisco is the name of a city located in California.

The city of San Francisco is not associated in general or in the computer industry with computer software. The Silicon Valley, which is a region in Santa Clara County located between San Jose and Palo Alto, is associated with computer technology. The Silicon Valley, however, does not include the city of San Francisco, and, in the industry, it is well known that

³ The declarants refer to applicant's mark as SAN FRANCISCO rather than SANFRANCISCO. Applicant's drawing was amended contemporaneously with the filing of the declarations.

computer software associated with the Silicon Valley is not associated with San Francisco. Because people in the computer industry do not associate the city of San Francisco with the production of computer software, they will not and have not assumed that IBM's SAN FRANCISCO software is produced in the city of San Francisco. Accordingly, I have not been deceived as to the origins of IBM's SAN FRANCISCO software. I have never seen anyone so deceived, nor do I believe there would be the possibility of such deception.

In my opinion, the term SAN FRANCISCO has no significance in connection with computer software, except to indicate IBM's SAN FRANCISCO software.

Firstly, we concur with the Examining Attorney's observation that "the declarants are all licensees of the applicant's software and therefore have an established relationship with the applicant which may color their opinions." (brief, p. 13) Secondly, we simply find that the other evidence of record, which clearly indicates that San Francisco is a location of origin of computer software, outweighs the form declarations. As for purchaser sophistication, we do not agree that this necessarily weighs in applicant's favor. This sophistication does not detract from what we perceive to be the likely reaction of

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a goods/place association upon encountering the mark
SANFRANCISCO for software.

Decision: The refusal to register is affirmed.

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